

8/15/01

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Paper No. **11**
Bottorff

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Hans Neschen AG**

Serial No. 75/724,732

Robert A. Vanderhye of **Nixon & Vanderhye P.C.** for **Hans Neschen AG**.

Linda M. Estrada, Trademark Examining Attorney, Law Office **105** (**Thomas G. Howell**, Managing Attorney).

Before **Chapman, Wendel and Bottorff**, Administrative Trademark Judges.

Opinion by **Bottorff**, Administrative Trademark Judge:

Applicant seeks registration on the Principal Register of the mark
FILMOPRINT, in typed form, for Class 16 goods identified in the application (as
amended) as follows:^{1[1]}

^{1[1]} Serial No. 75/724,732, filed June 8, 1999. The application is based on Trademark Act Sections 44(e) and 1(b), 15 U.S.C. §§1126(e) and 1051(b). In addition to the Class 16 goods, the application identifies goods in Classes 1 and 17. However, it is apparent from the Trademark Examining Attorney's arguments in her appeal brief that her refusal to register pertains only to Class 16, and not to Classes 1 and 17.

printed matter, namely printed films of plastic or paper for use in printing, marking and commercial wrapping; adhesive printed films of plastic or paper for use in printing and marking; adhesive and non-adhesive printable paper webs for printing; adhesive films for paper and stationary [sic] use; adhesive films for household use; plastic sheets and printable plastic sheets for writing, printing and marking.

The Trademark Examining Attorney has refused registration on the ground that applicant's mark, as applied to applicant's Class 16 goods, so resembles the mark FILMPRINT, previously registered (in typed form) for "adhesive labels,"^{2[2]} as to be likely to cause confusion, to cause mistake or to deceive. *See* Trademark Act Section 2(d), 15 U.S.C. §1052(d). When the refusal was made final, applicant filed this appeal.

Applicant and the Trademark Examining Attorney have filed main appeal briefs, and applicant has filed a reply brief. No oral hearing was requested. We affirm the refusal to register.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *See In re E.I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the

^{2[2]} Registration No. 1,381,318, issued February 4, 1986; Section 8 and 15 affidavits accepted and acknowledged.

goods and differences in the marks.” *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We turn first to the issue of whether applicant’s mark FILMOPRINT and registrant’s mark FILMPRINT, when compared in their entireties in terms of appearance, sound and connotation, are similar or dissimilar in their overall commercial impressions. The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. *See Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

We find that applicant’s mark FILMOPRINT and the cited registered mark FILMPRINT, while not identical, are nonetheless highly similar in terms of appearance, sound and connotation. Indeed, the marks are identical but for applicant’s insertion of the letter “O” between the words FILM and PRINT, a point of distinction which is insufficient to overcome the overall similarity between the marks’ respective overall commercial impressions.

Applicant argues that the one-letter difference between the marks is “dramatic,” and that it serves to distinguish registrant’s “sterile” mark FILMPRINT from applicant’s “flamboyant” mark FILMOPRINT. We are not persuaded. The average purchaser, who normally retains a general rather than a specific impression of trademarks, *see Sealed Air Corp, supra*, is likely to perceive and recall applicant’s mark as consisting primarily of the words FILM and

PRINT. The letter “O” in applicant’s mark does not significantly alter that general commercial impression of the mark; rather, it is likely to be perceived as merely separating the words FILM and PRINT. Those two words, which together comprise the entirety of the cited registered mark, remain readily recognizable in applicant’s mark.

We reject applicant’s contention that its mark would be perceived as a unique mark dominated by the coined word FILMO. Even if FILMO were perceived to be a word, it clearly is derived from and merely a minor variation on the word FILM, and that is how it is likely to be recalled by purchasers.

Likewise, we are not persuaded by applicant’s argument that it owns a “family” of three other registered FILMO marks,^{3[3]} that its present mark would be perceived as another member of that family, and that the mark accordingly would not be confused with the registered mark cited by the Trademark Examining Attorney. Even if we assume, *arguendo*, that an applicant’s ownership of a family of marks is legally relevant to the issue of whether the mark the applicant presently seeks to register is confusingly similar to the registered mark cited against it as a Section 2(d) bar, *cf. Baroid Drilling Fluids Inc. v. Sun Drilling Products*, 24 USPQ2d 1048 (TTAB 1992), we find that applicant in the present case has failed to prove that it in fact owns such a family of marks. Applicant has not

^{3[3]} Applicant refers in its briefs to the marks FILMOPLAST (Reg. No. 921,954), FILMOLUX (Reg. No. 921,955), and FILMOMATT (Reg. No. 937,588).

submitted copies of its alleged FILMO registrations, nor has applicant even identified the goods on which those other marks are used except to say that the goods are “similar to the present application.” Applicant certainly has not submitted any evidence proving that applicant has used and promoted the marks together as a family of marks. See *J&J Snack Foods Corp. v. McDonald’s Corp.*, 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991); *Trek Bicycle Corp. v. Fier*, 56 USPQ2d 1527 (TTAB 2000); *Hester Industries Inc. v. Tyson Foods Inc.*, 2 USPQ2d 1645 (TTAB 1987); and *American Standard Inc. v. Scott & Fetzer Company*, 200 USPQ 457 (TTAB 1978).

Finally, applicant argues that the words FILM and PRINT commonly appear in marks used in connection with goods of this type,^{4[4]} such that purchasers are accustomed to looking not to these weak terms but rather to the other portions of the marks in order to distinguish source. However, the Trademark Examining Attorney contends, without rebuttal from applicant, that the Office’s database contains only three registered marks which include both FILM and PRINT, and that only one of those three, i.e., the FILMPRINT mark

^{4[4]} Applicant has submitted third-party registrations (covering, inter alia, various adhesive film and label products) of the marks LETRAFILM, MACFILM, THERMLFILM, IMPCTFILM, POLYFILM, PRIME FILM, HOLOFILM, FUNKY FILMS, FREE FILM, FORM-X-FILM, ECOFILM, PLANPRINT, FASPRINT, U-PRINT, PLI-A-PRINT, CREAPRINT, EASY-PRINTS, and PRINTAC.

cited as a Section 2(d) bar to applicant's application, uses both of those words in a non-descriptive, source-identifying manner.^{5[5]}

Thus, even if we assume that FILM and PRINT are each weak terms as applied to the goods involved herein, the evidence of record does not support applicant's contention that the cited registered mark FILMPRINT, when viewed in its entirety, is a weak mark which is entitled only to a narrow scope of protection. Indeed, it is the only registered mark which, like applicant's mark, uses both FILM and PRINT in a non-descriptive sense. Applicant suggests that the Trademark Examining Attorney has improperly dissected the marks, but we find instead that it is applicant who is dissecting the marks by focusing on the alleged weakness of the individual words rather than on the marks in their entireties, each of which includes both words.

For the foregoing reasons, we find that applicant's mark and the cited registered mark are highly similar when viewed in their entireties, and that confusion would be likely to result from their use on related goods.

We turn now the question of the relationship between applicant's goods and registrant's goods. It is not necessary that the respective goods be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is sufficient that the goods are related in some manner or that the

^{5[5]} The other two registrations, which are owned by a single entity, cover the mark CPI COLOR PRINT FILM (in typed form and with a design, respectively) for "unexposed photographic film"; each of these registrations includes a disclaimer of COLOR PRINT FILM.

circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks used or intended to be used thereon, to a mistaken belief that they originate from or are in some way associated with the same source or that there is an association or connection between the sources of the respective goods. See *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991); *In re International Telephone & Telegraph Corp.*, 197 USPQ2d 910 (TTAB 1978). Moreover, the greater the degree of similarity between the applicant's mark and the cited registered mark, the lesser the degree of similarity between the applicant's goods and the registrant's goods that is required to support a finding of likelihood of confusion. See *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993); *In re Concordia International Forwarding Corp.*, 222 USPQ 355 (TTAB 1983).

Registrant's "adhesive labels" are not limited as to trade channels or classes of purchasers; we therefore presume that they are marketed in all normal trade channels and to all the usual classes of purchasers for such goods, including the commercial and household purchasers to whom applicant's goods, as identified, are directed. See *In re Elbaum*, 211 USPQ 639 (TTAB 1981).

Additionally, the Trademark Examining Attorney has submitted printouts of the following third-party registrations which cover Class 16 goods of the general type identified in applicant's application as well as goods of the general type identified in the cited registration: Registration No. 2,350,458 of the mark

GO FARTHER, in which the identification of goods includes both “printed labels not of textile” and various printed and non-printed paper goods including “stationery”; Registration No. 2,358,658 of the mark PERFECT IMPRESSIONS, in which the identification of goods includes “decorative and specialty printing paper and plastic transparency films in sheet, roll and fan-folded form for use in business machines and printers,” as well as “printed, blank and partially printed labels not of textiles”; and Registration No. 2,210,437 of the mark 4TH FLOOR, in which the goods are identified as “paper, plastic films, and labels for use with laser printers, ink jet printers, and color and monochrome copiers.” We also note that among the third-party registrations submitted by applicant, see *supra* at footnote 4, are Registration No. 1,788,127 of the mark POLYFILM for “printed label stock and labels, having a pressure sensitive adhesive,” and Registration No. 2,022,832 of the mark HOLOFILM for “self-adhesive plastic wrapping and packaging materials in sheet form, self-adhesive, preprinted non-textile labels and decals, all containing holograms.”

Although these registrations are not evidence that the marks shown therein are in commercial use, or that the public is familiar with them, they nevertheless are probative evidence to the extent that they suggest that the goods identified therein are of a type which may emanate from a single source under a single mark. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467 (TTAB 1988). We find that the registrations suffice to prove the requisite relationship between

applicant's Class 16 goods and registrant's adhesive labels; applicant's arguments to the contrary are not persuasive.^{6[6]}

For the reasons discussed above, we find that applicant's Class 16 goods, as identified in the application, are sufficiently related to the goods identified in the cited registration that confusion is likely to result from use thereon of the highly similar marks involved in this case.

Having carefully considered all of the evidence of record as it pertains to the relevant *du Pont* likelihood of confusion factors, we conclude that confusion is likely to result from applicant's use its mark on its identified Class 16 goods, and that registration of applicant's mark as to that class accordingly is barred by Trademark Act Section 2(d).

Decision: The refusal to register the mark as to Class 16 is affirmed.

However, the application shall proceed to publication as to Classes 1 and 17.

^{6[6]} The fact that these third-party registrations are only a few "out of more than two million registrations" on the Register does not detract from their probative value, under *Albert Trostel, supra*, on the question of the relationship between applicant's and registrant's goods. Nor are we persuaded that "the fact that Applicant owns at least three other registrations which do not include adhesive labels among the goods covered indicates that the trade channels are different and that the respective goods do not originate from the same source." (Applicant's reply brief at 4.) As noted above, applicant never made its purported registrations of record in this case. More importantly, applicant has cited absolutely no authority for the proposition upon which this latter argument is based, i.e., that third-party registration evidence which, under *Albert Trostel, supra*, is probative to show that the goods identified in the registrations may emanate from a single source under a single mark, can be negated or rebutted by evidence that there are other registrations on the Register which do not include both the applicant's and the registrant's types of goods.
